

REMARKS

Claim Amendments

In the amendments above, Claims 43 and 86 have been amended to more particularly point out and distinctly claim Applicants' invention.

§112, Second Paragraph Rejection

Claims 19, 41-44, and 74-94 have been rejected under 35 U.S.C. §112, second paragraph. The Examiner's attention is directed to the amendments to the claims above, where Claims 43 and 86 have been amended. It is believed that these amendments overcome this rejection.

§112, First Paragraph Rejection

Claims 19, 41-45, and 74-94 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner maintains that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More particularly, the Examiner maintains:

(1) that the subject matter not disclosed is how to make a unitary/signal electrode having a capacitance greater than 300 microfarads and less than 3000 microfarads, in combination with other elements in the claims, and

(2) that one skilled in the art could not practice/make the invention without undue experimentation to arrive at an electrode with a capacitance of 300-3000 microfarads.

Applicants respectfully traverse the above rejection.

To be enabling under 35 U.S.C. §112, a patent specification must sufficiently disclose an invention to enable those skilled in the art to make and use it. Not every step need be set forth in the specification, and the specification need not disclose what is well known in the art. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed.Cir. 1984).

The Examiner has characterized the "amount of direction" provided by the present application as "minimal." Applicants respectfully submit that the Examiner is not considering that there was abundant knowledge available to one skilled in the art as of November 1999 regarding the preparation of electrodes having a desired capacitance such that an art-skilled individual would have been able to practice the invention and practice the invention without undue experimentation.

The Examiner's attention is directed to the attached Supplemental Declaration Under 37 C.F.R. § 1.132 of Shawn Moaddeb (the "Declaration"). Mr. Moaddeb is an expert in the field of leads and electrodes, and he has extensive experience in the field of designing and manufacturing leads. He indicates what he would expect an art-skilled person to know or have access to how an electrode can be manufactured to have a capacitance within a desired range, such as within the range of from greater than 300 microfarads to less than 3000 microfarads. Mr. Moaddeb also indicates that the preparation of such electrodes would not involve undue experimentation.

In the present and prior Office Actions the Examiner posed or referred to several specific questions, which it is believed are substantially answered in the Declaration. With regard to how the porosity is changed, it should be noted that porosity will increase as the sputter layer thickness increases in combination with specific surface morphology (diamond-like). The higher the surface porosity, the higher the capacitance.

With regard to whether porosity is increased or decreased for the unitary/signal electrode, it should be noted that it is increased.

With regard to how the porosity changed for each of the different electrode materials, it should be noted that porosity increases and is established based on capacitance/polarization measurements.

With regard to how porosity affects the capacitance, it should be noted that there is a direct relationship between the porosity and the capacitance value. The higher the porosity, the higher the capacitance.

With regard to how the length, electrode material, thickness of the electrode material, etc., effect the capacitance, it should be noted that, in general, larger surface area equals larger capacitance values. The way to increase the surface area is to do one or a combination of the following: increase the length, increase the thickness of the coating, and increase the porosity of the electrode. Electrode material is also a factor. Different materials have different capacitance at equal surface areas. Materials with high capacitance values coupled with longer length, thicker coating, with high porosity, will be ideal.

Applicants respectfully submit that, consistent with the Declaration, the present claims are fully enabled and that the rejection under § 112, first paragraph, for lack of enablement should be withdrawn.

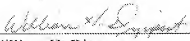
Should the claims herein be allowable but for minor matters that could be the subject of either a supplemental submission by Applicants or an Examiner's Amendment, Applicants would appreciate the Examiner's contacting Applicants' undersigned attorney. In the alternative, Applicants would appreciate the opportunity to conduct an interview with the Examiner prior to issuance of another Office Action and respectfully request that

the Examiner contact Applicants' undersigned attorney to discuss a mutually convenient time for doing so.

Reconsideration and allowance of all the claims herein are respectfully requested.

Respectfully submitted,

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